

REMARKS

Claims 1-21 were originally filed in the present Application. Claims 1-10 stand withdrawn pursuant to Election/Restriction Requirement. Claims 11-19 were examined in the Final Office Action mailed March 29, 2006.

The Examiner is thanked for his consideration in advancing the prosecution of this case, notwithstanding the error in the claim listing in the Applicants' prior submission. Claims 20-21 are now listed as canceled.

Section § 112, First Paragraph Rejection: Claims 11-19 stand rejected as not complying with the written description requirement for use of the terms "means for isolating" and "pressure sensor." The Applicants have amended claim 11 to return to the original "means for separating" language, and to recite a "pressure meter," which is discussed on pages 6-7 of the original Specification. Reconsideration and withdrawal of the pending § 112, second paragraph, rejection is respectfully requested.

Rejections Based On The Kononov Reference: Claims 11-19 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious in view of, U.S. Patent No. 4,881,176 to Kononov ("Kononov").

In response to the Examiner's helpful suggestions regarding the additional recitation of structure, the Applicants have amended claim 11 to recite several additional features of the present invention, including:

- reciting that the device includes device housing containing the switching means and internal connection lines (as shown in Fig. 1 (element 10));
- reciting that the filter or filter system to be tested is located externally to the device housing (as shown in Fig. 1 (element 18, external connection for connection to filter outside element 10));

- reciting that the switching means are switching valves (as discussed in the Specification at 4:7-10; 6:7-20);
- reciting that the external connections include: a compressed air supply connection through which compressed air is supplied in testing operation, a connection for internal venting, a connection for external venting, and a connection for an external reference tank (as discussed in the Specification at 6:7-20); and
- reciting that the internal volumes are the connecting lines between the switching valves, connecting lines between the switching valves and the external connections, connecting lines between the internal reference tank and a switching valve, the internal reference tank, and the volumes of switching valves (as discussed in the Specification at 5:12-16; 6:21-27).

Turning to the Kononov reference, and the remarks indicating that internal/external distinctions are “relative terms,” the Applicants respectfully submit that these terms have particular significance in the context of the present invention. As amended to recite a device housing, claim 11 recites the components accommodated within the “housing” of the filter testing device. in this context, the term “external” is used for parts or components outside the “housing,” and which do not directly belong to the filter testing device, as shown in Fig. 1 (e.g., the external reference tank 22 arranged outside the filter testing device; external connection 18 for connecting a filter external to the device housing). In contrast, Kononov teaches – in Kononov’s own words – an “*in-situ*” apparatus to clean a filter housing, not a stand-alone apparatus to which filters are attached for testing. Kononov, Abstract. Moreover, the “housing” referred to by Kononov is *a housing (10) containing a filter*, which is contained within Kononov’s array of piping and valve components – the exact opposite of the presently claimed filter testing device. Kononov therefore does not disclose or suggest the filter testing device structure and arrangements recited in claim 11.

As a separate grounds for allowance of the pending claims, the Applicants note that Kononov also does not disclose all of the external connections recited in amended claim 11. In the pending Final Office Action, it is maintained that Kononov discloses a device 8 having internal volumes and external connections connected to the filter housing, a cleaning supply, a compressed air source which is equated to the external tank, and an internal tank (the filter housing 10 of Kononov Fig. 1). March 29, 2006 Final Office Action at 5-6. However, the filter testing device according to the present invention has a compressed air supply connection *and* an external reference tank connection. Moreover, the filter testing device according to the present invention has a filter connection *and* an internal reference tank. Thus, Kononov does not anticipate or suggest all features, and hence all the functionality, of the invention recited in amended claim 11.

Finally, with regard to obviousness, the Applicants respectfully submit that it would not have been obvious to modify Kononov's in-situ filter arrangements to obtain the filter testing device now recited in amended claim 11, as this would have involved a radical rearrangement of the Kononov components, rendering it unsuitable for its original purpose (in this case, providing means to test and in situ filter without removal of the filter from its operating location and without consequent contamination of external environs. MPEP § 2143.01 (proposed modification cannot render the prior art unsatisfactory for its intended purpose).

In sum, because Kononov fails to teach or suggest all of the features of the present invention recited in amended claim 11, and it would not have been obvious to modify the Kononov in-situ filter analysis apparatus to obtain the present invention, amended claim 11 and its dependent claims 12-19 are patentable over this reference under § 102(b) and § 103(a). Accordingly, reconsideration and withdrawal of the pending rejections is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, the Applicants respectfully submit that claims 11-19 are now in condition for allowance. Early and favorable consideration and issuance of a Notice of Allowance for these claims is respectfully requested.

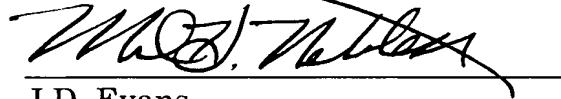
If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit

Account No. 05-1323 (Docket #010743.52910US).

Respectfully submitted,

September 29, 2006

A handwritten signature in dark ink, appearing to read "J.D. Evans", is written over a horizontal line.

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